

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Reconsideration of the Application in view of the following remarks is respectfully requested.

Incomplete Examination Of Patent Application Claims

In the present Application, as originally filed, Applicants have presented forty-two claims for examination, including four independent claims and thirty-eight dependent claims. In this initial Office Action, although the Examiner does not specifically refer to any of Applicants' claims by number, it appears that a substantive examination has been provided for only the four independent claims. In other words, thirty-eight of the originally-filed claims have received no substantive examination. Specifically, claims 2-20 and 22-40 have been given *no substantive examination* in the initial Office Action.

Applicants therefore respectfully submit that Applicants' originally-filed claims have not received an adequate examination. Applicants also submit that claims 2-20 and 22-40 contain a substantial number of patentable elements and functionalities, and therefore merit a more thorough and complete examination. Applicants therefore respectfully request the Examiner to issue a new non-final Office Action that specifically and substantively addresses each of Applicants' dependent claims 2-20 and 22-40 (referenced by claim number), or in the alternative, to reconsider and allow claims 1-42 so that the present Application may issue in a timely manner.

Notice Of Draftsman's Patent Drawing Review

In paragraph 2 of the Office Action, the Examiner requests the Applicants to "note PTO-948 concerning notice of draftsman's patent drawing review." The Examiner further states that "correction of the noted defect can be deferred until the application is allowed by the examiner." However, Applicants have not received a PTO-948 or any other document regarding defects in the drawings. Applicants respectfully request the Examiner to provide such documents, if necessary, so that Applicants may respond in an appropriate manner.

35 U.S.C. § 103

In paragraph 3 of the Office Action, the Examiner rejects claims 1-42 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,446,737 to Cidon et al. (hereafter Cidon) in view of U.S. Patent No. 5,819,047 to Bauer et al. (hereafter Bauer). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Cidon according to the teachings of Bauer would produce the claimed invention. Applicants submit that Cidon in combination with Bauer fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Cidon nor Bauer contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Cidon essentially teaches allocating resource *quotas* depending upon the number of current requests for resources (see column 1, line 58 to column 2, line 39). However, the Examiner concedes that Cidon fails to teach Applicants' claimed "resource characterization". Applicants concur.

The Examiner then points to "controlling resource usage" as taught by Bauer to purportedly remedy this defect. Bauer essentially teaches allocating additional resources to a particular system user only when a network-wide *quota* for the user is not exceeded (see column 2, line 56 to column 3 line 6). Applicants respectfully submit that neither Cidon nor Bauer teach or suggest a "resource characterization" as taught and claimed by Applicants.

In both Cidon and Bauer, the disclosed “quotas” represent a maximum amount of allocatable resources that may be utilized by a given system user. However, in direct and opposite contrast to the cited references, Applicants’ claimed “resource characterization” represents a minimum amount of acceptable resources for optimally servicing a requested process (see Specification, lines 18 to 24). Applicants therefore submit that neither Cidon nor Bauer teach or suggest Applicants’ claimed “resource characterization”.

For at least the foregoing reasons, Applicants submit that both Cidon and Bauer *teach away* from Applicants’ invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

Also, with regard to combining Cidon and Bauer, the Examiner states that “[i]t would have been obvious to one in the ordinary skill in the art” to modify Cidon with the teachings of Bauer, “in order to prevent network usage exceed assigned consumption quotas.”

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention may not act as the required teaching to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements

from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Applicants suggest that merely because certain isolated aspects from cited references produce a beneficial result, this fact alone does not provide the requisite teaching for properly combining references under 35 U.S.C. §103. Applicants therefore respectfully request the Examiner to provide citations to specific sections of the cited references that explicitly indicate teachings for combining the references.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in the other independent claims which are discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicants respectfully submit that, in light of the substantial differences between the teachings of Cidon/Bauer and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of Cidon/Bauer. Applicants specifically direct the Examiner’s attention to Applicants’ discussion of FIGS. 5-6 (Specification, page 10, line 1 through page 12, line 19) which describes in detail the Applicants’ claimed “means for handling said requested process based upon said resource characterization.”

Regarding the Examiner's rejection of dependent claims 2-20 and 22-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-20 and 22-40 so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 1-42 are not unpatentable under 35 U.S.C. § 103 over Cidon in view of Bauer, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-42 under 35 U.S.C. § 103.



Summary

Applicants submit that the foregoing remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner.

Respectfully submitted,

Date: _____

7/9/02

By: _____

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